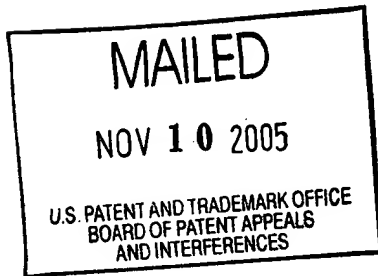


UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HIROFUMI MIRASAKI and TAKEHIRO KAMINAGAYOSHI



Appeal No. 2005-1584
Application No. 08/828,417

ON BRIEF

Before KRASS, GROSS, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 23-28, 31, and 33-44. (Final Rej. at 2.) The appellants appeal only the rejection of claims 23-28 and 39-44, (Appeal Br. at 2), under 35 U.S.C. § 134(a). We reverse.

I. BACKGROUND

The invention at issue on appeal concerns video games. Video games using computer technology have become ubiquitous. Video ball games, such as baseball or soccer, are especially popular. Some such games generate speech to simulate a running commentary of the game. (Spec. at 1.)

According to the appellants, conventional video games that generate a running commentary employ "a 1:1 relationship," (*id.*), between game situation and generated commentary. Because the same word or phrase is output each time the same situation arises, the game unavoidably becomes mannered. (*Id.* at 2.)

In contrast, the appellants' invention does not always output the same phrase when the same situation occurs in a video ball game. Instead, plural phrases are made to correspond to a single situation. When this same situation recurs, the same phrase may or may not be reproduced. For example, assume the following situation in a baseball game: a runner is on first base, and the batter hits a single. The invention randomly selects a response and outputs a phrase, such as "(player's name) HITS A SINGLE!" or "IT'S A HIT!" (Appeal Br. at 14.)

A further understanding of the invention can be achieved by reading the following claims.

23. A speech outputting game machine, comprising:

a plurality of phrase databases each corresponding to predetermined condition and each storing a plurality of command data including at least one or more commands representing a plurality of phrases some of which are related and equally appropriate for a specified predetermined condition, at least a first database having stored therein phrases in the voice of a first person and at least a second database having stored therein phrases in the voice of a second person;

switching means for switching from one of said first and second databases to the other of said first and second databases;

processing means for selecting a phrase database corresponding to a predetermined condition when said predetermined condition is satisfied during the progress of the game, for selecting a specific command data based on predetermined procedures among the plurality of command data stored in the selected phrase database, and for outputting one of a plurality of alternative related phrases based on the command included in the selected specific command data; and

a speech output device for outputting a speech based on the phrase output from said processing means whereby different ones of said plurality of alternative related phrases may be generated upon the occurrence of the same condition during the progress of the game.

39. A speech outputting game machine, comprising:

a plurality of phrase databases each corresponding to predetermined condition and each storing a plurality of command data including at least one or more commands representing a plurality of phrases some of which are related and equally appropriate for a specified predetermined condition;

processing means for selecting a phrase database corresponding to a predetermined condition when said predetermined condition is satisfied during the progress of the game, for selecting a specific command data based on predetermined procedures among the plurality of command data stored in the selected phrase database, and for outputting one of a plurality of alternative related phrases based on the command included in the selected specific command data; and

a speech output device for outputting a speech based on the phrase output from said processing means whereby different ones of said plurality of alternative related phrases may be generated upon the occurrence of the same condition during the progress of the game, said processing means uses said second phrase database according to replacement conditions designated by a player and the language of said

first phrase database being different from the language of said second phrase database.

Claims 23-28 and 39-44 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,735,743 ("Murata"); U.S. Patent No. 5,695,401 ("Lowe"); U.S. Patent No. 5,393,073 ("Best '073"); U.S. Patent No. 4,333,152 ("Best '152"); and U.S. Patent No. 5,712,950 ("Cookson").

II. OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the main point of contention therebetween. The examiner asserts, "The alternative phrase are [sic] different phrases based on the play of the game as evidenced Murata '743 which gives as an example for the batting scene a combination of the vocal sounds associated with that scene; 'STRIKE', 'BATTER OUT,' 'THREE MEN OUT'." (Examiner's Answer at 4.) The appellants argue, "reviewing the announcements in each of the Murata et al. scenes, starting at column 3, line 48, through column 4, line 11, it will be noted that none of the announcements are related to each other in the sense that no two, or three, or more, are substantially synonymous and relate to the same game event, so that no one announcement can be interchanged for any other announcement in a set." (Appeal Br. at 9.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, independent claims 23 and 39 recite in pertinent part the following limitations: "phrase databases each corresponding to predetermined condition and each storing a plurality of command data including at least one or more commands representing a plurality of phrases some of which are related and equally appropriate for a specified predetermined condition. . . ." Considering these limitations, the independent claims require the use of multiple phrases that are equally appropriate for the same condition.

B. OBVIOUSNESS DETERMINATION

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Murata "provide[s] a game machine which can execute play-by-play announcement. . . ." Col. 1, ll. 54-56. "FIG. 1 is a block diagram showing a principal arrangement of [the] game machine of the present invention." Col. 3, ll. 16-17. "A vocal sound data storage portion 4 stores various data of groups of vocal sounds required for play-by-play announcement in association with development of game. . . ." *Id.* at ll. 37-39. "The main CPU 3 successively designates an appropriate vocal sound group to be used in the play-by-play announcement in accordance with the development of game. . . ." Col. 4, ll. 24-26.

No two of the reference's vocal sound groups, however, are equally appropriate for the same condition. To the contrary, only one vocal sound group is appropriate for each condition. "For example, in the case of a pitched ball being a strike, the main CPU 3 designates the vocal sound group 'STRIKE'. . . ." Col. 5, ll. 20-22. In other words, when a pitched ball is a strike, the only vocal sound group responsive thereto is "STRIKE." "Further, if this 'STRIKE' is a third strike, the main CPU 3 also designates the vocal sound group 'BATTER OUT'. . . ." *Id.* at ll. 23-25. In other words, when a strike is the third strike, the only vocal sound group responsive thereto is "BATTER OUT." "Furthermore, if three men are out in this instance, the CPU 3 also designates the vocal sound group 'THREE MEN OUT'. . . ." *Id.* at ll. 26-28. In other words, when three men are out, the only vocal sound group responsive thereto is "THREE MEN OUT."

The examiner does not allege, let alone show, that the addition of Lowe, Best '073, Best '152, or Cookson cures the aforementioned deficiency of Murata. Absent a teaching or suggestion of the use of multiple phrases that are equally appropriate for the same predetermined condition, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claim 23; of claims 24-28, 40, 42, and 44, which depend therefrom; of claim 39; and of claims 41 and 43, which depend therefrom.


CONCLUSION

In summary, the rejection of claims 23-28 and 39-44 under § 103(a) is reversed.


ERROL A. KRASS)
Administrative Patent Judge)

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge

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LANCE LEONARD BARRY
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